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OFFICE OF PETITIONS

In re Application of :
Lundblade : DECISION ON APPLICATION
Application No. 10/697,397 : FOR PATENT TERM ADJUSTMENT
Filed: October 29, 2003 :
Attorney Docket No. **030457** :

This is a decision on the "REQUEST FOR RECOSENDIERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)" filed August 15, 2011. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 585 days to 704 days.

The application for patent term adjustment is **DISMISSED**.

On May 13, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 585 days. On August 15, 2011, applicants timely submitted the instant application for patent term adjustment¹.

By the instant petition, applicant asserts that the patent term should be adjusted by 119 days, pursuant to 37 CFR 1.702(a)(2). In summary, applicant asserts that the Notice of Allowance and Issue Fee Due mailed October 9, 2009, was effectively withdrawn by the examiner by the issuance of a non-final Office action on May 14, 2010, that indicated it was responsive to the reply filed September 15, 2009. Applicant concludes that the period of adjustment to the patent term under 37 CFR 1.702(a)(2) is properly calculated using the May 14, 2010, non-final Office action, rather than the October 9, 2009, Notice of Allowance and Issue Fee Due.

¹ The Office records show that the issue fee was received on August 15, 2011.

Applicant's arguments have been considered but are not persuasive. It is concluded that no period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(2) is warranted.

It is undisputed that the Office mailed an action under 35 U.S.C. 132 in the form of a Notice of Allowance and Issue Fee Due on October 9, 2009, within four months of the reply under 37 CFR 1.111 filed September 15, 2009. The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after four months from the filing of the reply under 37 CFR 1.111 or appeal taken. The fact that the Office later mailed a non-final Office action does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(2) on October 9, 2010. Further, relative to the determination of patent term adjustment, the examiner does not have the authority to vacate, rescind, or withdraw an Office action. Unless expunged from the record, for purposes of calculating patent term adjustment, the action originally mailed by the examiner on August 24, 2009, was properly used to calculate the adjustment to the patent term, if any, pursuant to 37 CFR 1.702(a)(2) and 37 CFR 1.703(a)(2). See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, no period of adjustment to the patent term pursuant to 37 CFR 1.702(a)(2) will be entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains 585 days.

Deposit account 17-0026 will be charged \$200.00 for the fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years

to issue the patent (to the extent that the three-year period does not overlap with periods already accorded¹).

Telephone inquiries specific to this matter should be directed to the undersigned (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Attorney Advisor
Office of Petitions

¹ See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR ' 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).